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EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/584,664	MYSORE ET AL.	
	Examiner	Art Unit	
	Patricia A. George	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 September 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 11-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 11-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 9, and all claims depending on them, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 remains indefinite because the ratios of the ingredients recited in step (vi) are still unclear. It is not clear whether the numbers at the end of the process step are units of measurement, percentages, weight percent of each ingredient, or ratios of the pepper to other ingredients, etc. Applicant's amendment to include the phrase "(weight of individual component / total weight of the mix)" did not clarify the issue and in fact renders the claim as further indefinite because phrases which are claimed in parenthesis can be interpreted as an example of what the claim is indicating, not a clear and definite recitation of a limitation. Furthermore, the phrase "(weight of individual component / total weight of the mix)" is not in the same format of the numbers so it is difficult to try to make a correlation to the numbers listed; and it appears that step vi is claiming the pepper has a ratio in some long list of ranges because the ingredient of pepper is not separated from the ratio nomenclature by punctuation. For example, a definite quantity for an ingredient used in a method is: mixing 50 percent by weight of

skim milk; 80 percent by weight of corn flour; and wherein percents by weight are of the total weight of the mixture.

Claim 9 is indefinite because the claim recites the use of "native potato flour" in the soup mix, and the phrase comprises the indefinite term "native".

The term "native" in claim 9 is a relative term which renders the claim indefinite. The term "native" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention because there is no point of relativity provided for the proximity that defines "native" and therefore those of skill in the art can make a variety of different conclusions, such as from the same: city, county, country, or continent. Further, the term "native" is indefinite because it has a variety of different meanings, such as being from a place of origin, or having a characteristic of something from the place of origin.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 7-9, and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spaeti et al. in view of the combination of Harris et al., Dill, Mid Hill Nursery, Murakami, Siamon, and Willard.

The references of Antioxidant Properties of Dry Soup is relied on for evidence.

Mid Hill Nursery is of "A List of Popular Herbs", published 2/09/2002.

Siamon of is USPN 6,432,425.

With regard to the prior art, the phrase "in the range of 10-20....(weight of individual....), respectively," encompasses a quantity of each of the specifically claimed food ingredients.

As to claim 1, applicant claims a process for making a dry soup mix, the process steps comprise: mixing a preparation of pulverized ingredients and drying them, the claimed preparation of the soup mix concoction is merely the addition of common ingredients, and the preparation of such ingredients by using a combination of previously known food science methods step.

Spaeti et al. discloses the process of making a dry, granular instant soup mix (Abstract) by mixing a variety of pulverized ingredients and drying them. See reference starting at the Summary of the Invention.

The instant soup mix of Spaeti et al. discloses mixing a preparation of several of the claimed ingredients, such as: skim milk powder (15.5% by weight), corn flour (21% by weight), potato flour (5% by weight), wheat flour (13% by weight), chicken fat (3% by

weight), salt (10% by weight), sugar (5% by weight), and onion powder (1% by weight) (Example 2).

Spaeti et al. teaches the mix granules of the dry soup are ground to have sizes in the range of 10 mesh (2000 microns) to 60 mesh (250 microns), which appears to encompass the claim of 400 to 600 microns used to obtain dill powder, potato flour, and onion powder. See reference Summary, and column 2.

Spaeti et al. does not teach the final moisture content of the dry mixture, and a variety of the claimed commonly known flavorings which are both known in the art to be suitable for the purpose of making a dry soup mix.

Harris et al. discloses a dry soup mix containing maltodextrin (11.05% by weight); a mixture of ground herbs and spices including pepper (1.33% by weight) and leafy herbs like rosemary, and thyme (Col. 3, lines 35-45; Col. 4, line 40). Harris et al. discloses the final moisture content to be no greater than 5% by weight (Col. 2, lines 36-38).

Harris teaches that such a combination provides the benefits of: the dry soup mix having a flavorful low salt content which is desirable to those on a low salt diet; and the provision of a uniformly blended and free flowing mix of substantially dry edible components. (Col. 1, lines 50-55).

It would have been obvious to one of ordinary skill in the soup art at the time of the invention to modify the soup mix of Spaeti et al. to include the maltodextrin, various herbs and spices, and final moisture content of Harris et al. because it would allow the final product to be low salt and full flavored and easily mixed with water. Harris et al.

does not disclose the addition of ground dill leaves as a flavoring or herb to the dry soup mix. However, Harris does disclose that various leafy herbs like rosemary, thyme, turmeric, and clove can be ground and used to flavor the dry soup mix (Col. 3 lines 35-45).

Mid Hill Nursery discloses that rosemary, thyme, and dill are all known to be used in soups, and therefore provide one of skill with a reasonable expectation of success that the herbs are equivalent substitutions for herbs used in soups. Dill discloses that dill or Indian dill can be ground or dried and used in soups (NPL Document, Page 1-2). Further, the type of herb selected for a soup would be a matter of design choice and therefore be within the skill of one in the art.

It would have been obvious to one of ordinary skill in the soup art at the time of the invention to modify the dry soup mix, of Harris et al., to include a step of using ground or dried dill or Indian dill, as claimed because dill is known to be an added flavoring to soups (Dill; Page 1-2), and also an equivalent substitution for rosemary or thyme as taught by Mid Hill Nursery, and therefore one of skill in the art would have a reasonable expectation of success in the selection of ground or dried Indian dill to flavor soups, because the art has illustrated that dill is suitable for the intended use of soups, and further the selection of a flavoring for a soup would be a matter of design choice which one of skill would clearly possess.

The modified teaching of Spaeti et al., teaches to use dried and ground dill, potatoes, and onions, as starting ingredients for the dry soup mix, and therefore does not teach known steps for preparing the dried powdered products that go into a dry soup mix.

Murakami discloses a method for manufacturing mulberry leaf powder by first washing the picked leaves to clean them (Col. 1, lines 49-50, 59-60). Murakami also discloses soaking the leaves in a solution containing sodium bicarbonate and salt that is added to water in a ratio of 0.01-1% (Col. 1, lines 64-67-Col. 2, lines 1-4). After soaking, the leaves are dried in a drying machine at a temperature of about 80°C (Col. 2, lines 26-29) and pulverized (i.e. cut into shreds and powdered) to a size of about 75-300μm (Col. 2, lines 43-49).

Siamon teaches that sodium bicarbonate is well known as being effective for topical treatments as an antibacterial, antiseptic, and anti-fungal, which would be beneficial when preparing fresh herbs, so that the end product would have a longer shelf life due to the reduction of bacteria and fungus that promotes the rot of organic matter.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the method of using dry dill, as Spaeti et al, to include steps of making the dry dill, as claimed, because the combination of Murakami and Siamon provide one of skill in the art with a reasonable expectation of success by illustrating the benefits of using such a method includes killing bacteria on the food

substance and that the art finds such a method of treating herbal leaves as suitable for cutting, soaking, drying, and powdering (i.e. pulverizing) herbal leaves.

It is the examiners position that the process parameters of solution strength, soaking time, and drying temperature are known result effective variables. If the solution strength were low it would result in less bacterial kill; if the soak time was high it would result in herbal flavor loss; and if the drying temperature were high it would result in burnt or over cooked herbs having an off flavor. Therefore, it would have been obvious to one with skill in the art at the time of the invention to determine the optimal value for the specifically claimed process parameters for the treatment of the dill, to provide a useable dried dill product for the process of making a soup mix, as the modified teaching of Spaeti et al., through routine experimentation, to impart the dill herb with the desired properties and flavors associated with the desired results of the dry soup mix. The selection of something based on its known suitability for its intended use has been held to support a *prima facie* case of obviousness. Sinclair & Carrol Co. v Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07.

Willard discloses powdering dried potatoes, for the intended use of an instant soup mix. See col. 4, lines 7--9; Fig. 1, #20; and col. 5, lines 4-12; Fig. 1, #42; col. 3, lines 22-26.

It would have been obvious to one of ordinary skill in the soup art at the time of the invention to modify the dry soup mix of the modified teaching of Spaeti et al., to include steps of dehydration and powdering potatoes, as claimed, because the teaching

by Willard provides one of skill with a reasonable expectation of success by illustrating that the art finds his methods suitable for dehydrating the potatoes into potato flour for the intended use of an instant soup mix (Col. 3, lines 22-26). Furthermore, although, Willard does not disclose the powdering of dried onion shreds, the process of Willard is capable of processing a number of various products (Col. 3, lines 18-21); therefore, one having ordinary skill in the art at the time of the invention could use the dehydration methods of Willard to create dried onion powder.

One of skill in the art would be motivated to look to the teaching in the art on the preparation of dried ingredients when making a dried soup mixture, from a supply of fresh ingredients, because it would be convenient to employ method steps that have already been shown by the art as being suitable for a similar intended purpose of obtaining dried ingredients which are suitable for making soup mixtures. See reference starting at MPEP 2144.07 Art Recognized Suitability for an Intended Purpose.

Therefore, a person of ordinary skill will be able to fit the teachings of the multiple applied references together like pieces of a puzzle though the inferences and creative steps that a person of ordinary skill in the art would employ. The hypothetical person having ordinary skill in food science, would, of necessity have the capability of understanding the required steps of preparing the claimed instant soup mix.

Further attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in fact situation of the instant case. At page 234, the Court stated as follows:

> This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected and useful function. In re Benjamin D. White, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

Regarding claim 2, the modified teaching of Spaeti et al., discloses soaking the herbal leaves in sodium bicarbonate but is silent to the ratio of shreds to solution, as in claim 2, however such a step would be obvious because Antioxidant Properties of Dry Soup (page 2, col. 2, lines 1-2) provides evidence that the ratio of shreds and sodium bicarbonate solution inherently allows for improved color fixation and retention during storage.

Therefore it would have been obvious to one with skill in the art at the time of the invention to determine the optimal value for the ratio of the shreds and soaking solution used in the process of making dry soup mix, as the modified teaching of Spaeti et al., through routine experimentation, to impart the herbal shreds with the desired color fixation associated with the ratio to the soaking solution. The selection of something based on its known suitability for its intended use has been held to support a *prima facie* case of obviousness. Sinclair & Carrol Co. v Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07.

Therefore, it would have been obvious to one of ordinary skill in the soup art at the time of the invention to modify the process of making dry soup mix of the modified

teaching of Spaeti et al. to include a step of soaking leaves in the sodium bicarbonate solution in a ratio of 1:2, as claimed because one of skill in the art would find a reasonable expectation of success in the evidence provided by Antioxidant Properties of Dry Soup that illustrates that such ratios improve the color fixation and retention of the herb during storage.

Regarding claim 3, the modified teaching of Spaeti et al., in Willard, discloses the drum drying of the root vegetables. See col. 4, lines 7--9; Fig. 1, #20; col. 3, lines 18-21.

Regarding claims 7-9, since the modified teaching of Spaeti et al., provide a similar soup mixture, as claimed, using similar ingredients, made in a similar manner, one of skill would have a reasonable expectation that such a method of making soup would provide similar properties, such as the viscosities of claims 7-9.

Regarding claim 11, the modified teaching of Spaeti et al., in Harris et al., discloses packaging the dry soup mix in a polyethylene film laminate coated with aluminum that is bonded to polyester (Col. 6, lines 16-22). The total bag thickness of Harris et al. is 0.00035 inches (280 gauge) thick (Col. 6, line 19), which is very close to the claimed range of a 250 (0.0004") gauge bag. Harris et al. teaches the package will not impart any odor or flavor the finished product (Col. 6, lines 21-22). Therefore, since the range for the bag thickness is so close to that of the instant claims, one of skill would have expected compositions that are in such close proportions to those in prior

art to be prima facie obvious, and to have same properties. *Titanium Metals Corp.*, 227 USPQ 773 (CAFC 1985).

In addition, since the modified teaching of Spaeti et al., provide a similar soup mixture, as claimed, using similar ingredients, made in a similar manner, one of skill would have a reasonable expectation of success that a method of making a similar soup would provide similar properties, such as the packaged dry soup mix will have a shelf life of 8 months in 65% humidity at room temperature as presently claimed.

Regarding claim 12, Spaeti et al. discloses mixing the dry soup mix with hot water to form an instant soup but is silent to the ratio of soup mix to water; however, it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the amount of soup mix and water to attain the most flavorful final product for the intended application, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 14, the reference of Spaeti et al. discloses an instant soup mix. See reference starting at the Abstract.

Regarding claims 13 and 15, the modified teaching of Spaeti et al., further teaches a free flowing instant soup mix with a moisture content of 3-5% (Harris et al.,

Abstract), a critical moisture content of 7-11% (Spaeti et al., Example 1) and 3% fat (Spaeti et al., Example 2).

Furthermore, since the modified teaching of Spaeti et al., provides a method for making a similar soup mixture, as claimed, using similar ingredients, and using similar process steps, therefore, one of skill would have a reasonable expectation that such a method of making soup would provide similar properties, such as: the free fatty acid mg/g is about 3.36, the peroxide value/g: nil, hunter color values as L, a, b is L: 73.0, a: -4.137, and b: 16.13 and total plate counts is about 18750/g and yeast and molds is not present as presently claimed.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spaeti et al., in view of the combination of Harris, Dill, Mid Hill Nursery, Murakami, Siamon, and Willard, as applied to claims 1-3, 7-9, and 11-15 above, further in view of the combination of Burrows et al., Hilton, and Tschirgi.

The references of: Antioxidant Properties of Dry Soup, and Borders et al., are relied on for evidence.

Regarding claim 4, the modified teaching of Spaeti et al., in Willard, discloses the process of dehydrating potatoes by first slicing the potatoes to a desired thickness, precooking the potatoes at a temperature between 155-175ºF (68.3-79.4ºC) in water for a period of 20 minutes, further cooling the potatoes to 60ºF (15.6ºC), again cooking the potatoes for 20-40 minutes in the water at 155-175ºF (68.3-79.4ºC), mashing the potatoes, drying the potatoes in a drum dryer, and finally powdering the potatoes in a

sieve with a pore size of 0.045 inches (Col. 3, lines 60-75-Col. 4, lines 1-15; Col. 5, lines 4-12; Fig. 1, #20, 42).

Regarding the cooling time for the potatoes, Willard requires the potatoes to cool to 60ºF (15.6ºC) and the claimed limitation toward cooling requires a range of between 12-17ºC for about 15-20 minutes. Since Willard's disclosed temperature falls within the claimed range, one of skill would have a reasonable expectation of success that an added step of the claimed ranges would be effective.

The modified teaching of Spaeti et al., does not disclose precooking the potatoes by autoclaving or the addition of potassium metabisulfite, whey protein concentrate, and monosodium glutatmate to the potato mash.

Burrows et al. discloses steam blanching (autoclaving) potato strips before cooking and drying them (Col. 3, lines 30-36; Example 1).

Hilton discloses the addition of 0.3% aqueous solution of sodium metabisulfite (Example 5) and 1 part by weight of monosodium glutamate (Col. 4, lines 38-42; Example 1) to potatoes to form potato products. Tschirgi discloses the addition of sweet dried whey to a liquid potato product that is further dehydrated (Col. 1, lines 51-60; Example).

It would have been obvious to one of ordinary skill in the potato art at the time of the invention to modify the process of dehydrating potatoes, of the modified teaching of Spaeti et al., to include the steam blanching (autoclaving) of Burrows et al. because it would minimize the leaching of natural sugars and flavor components, inactivate the enzymes present in the raw potato that induce oxidation (Col. 3, lines 37-41).

It would also have been obvious to one of ordinary skill in the potato art at the time of the invention to modify the process of dehydrating potatoes, of the modified teaching of Spaeti et al, to include the addition of sodium metabisulfite and monosodium glutamate, of Hilton, because Borders et al. provides evidence that the sodium metabisulfite inhibits post-slice browning and darkens the potatoes (see col. 8, lines 50-54) and Hilton further teaches that monosodium glutamate improves the flavor, color, and other properties of the final product. See reference starting at col. 4, lines 37-41.

It would have been further obvious to one of ordinary skill in the potato art at the time of the invention to modify the process of dehydrating potatoes, of the modified teaching of Spaeti et al , to include the addition of whey, as claimed, because Tschirgi teaches the benefit of the potato retaining its natural coloring and appearance (Col. 1, lines 60-61). Furthermore, one of skill in the art at the time of the invention would substitute sodium metabisulfite for the potassium metabisulfite because they have the same function in the applicant's presently claimed invention.

Hilton discloses the addition sodium metabisulfite and monosodium glutamate to potatoes but is silent to the exact amounts added; however, it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the amount of sodium metabisulfite and monosodium glutamate because it would inhibits post-slice browning and darkens the potatoes (Borders et al., Col. 8, lines 50-54) and the monosodium glutamate improves the flavor, color, and other properties of the final product (Hilton; Col. 4, lines 37-41) for the intended application, since it has been held

that discovering an optimum value or a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Tschirgi discloses the addition sweet dried whey to potatoes but is silent as to the exact amounts added; however, it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the amount of whey because it would allow the potato to retain its natural coloring and appearance (Col. 1, lines 60-61) for the intended application, since it has been held that discovering an optimum value or a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 5, the modified teaching of Spaeti et al., in Willard, also discloses the process of dehydrating potatoes by first slicing the potatoes to a desired thickness and finally powdering the potatoes in a sieve with a pore size of 0.045 inches (Col. 3, lines 60-75-Col. 4, lines 1-15; Col. 5, lines 4-12; Fig. 1, #20, 42).

The modified teaching of Spaeti et al. does not disclose autoclaving the potatoes, the addition of potassium metabisulfite, and drying the potatoes in a cabinet dryer.

Burrows et al. discloses steam blanching (autoclaving) potato strips and drying the potatoes in a cabinet dryer from 150-225ºF (65.6-107.2ºC) for 4-15 minutes (Col. 3, lines 30-36; Col. 4, lines 10-18; Example 1). Hilton discloses the addition of 0.3% aqueous solution of sodium metabisulfite (Example 5).

It would have been obvious to one of ordinary skill in the potato art at the time of the invention to modify the process of dehydrating potatoes, of the modified teaching of

Spaeti et al., to include the autoclaving and drying the potatoes in a cabinet dryer of Burrows et al. because it would minimize the leaching of natural sugars and flavor components, inactivate the enzymes present in the raw potato that induce oxidation (Col. 3, lines 37-41). Furthermore, the use of a cabinet dryer is also well known in the art. It would have been obvious to one of ordinary skill in the potato art at the time of the invention to modify the process of dehydrating potatoes, of Willard, to include the addition of sodium metabisulfite of Hilton because the sodium metabisulfite inhibits post-slice browning and darkens the potatoes (Borders et al., Col. 8, lines 50-54).

Furthermore, one of skill in the art at the time of the invention would substitute sodium metabisulfite for the potassium metabisulfite because they have the same function in the applicant's presently claimed invention.

In addition, since the temperature of Burrows et al. is substantially close to that of the instant claims, one of ordinary skill would have expected temperatures that are in such close proportions to those in prior art to be prima facie obvious, and to have the same properties. *Titanium Metals Corp.*, 227 USPQ 773 (CAFC 1985).

The modified teaching of Spaeti et al., in Burrows et al., discloses the addition of sodium metabisulfite to potatoes but is silent as to the exact amounts added; however, it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the amount of sodium metabisulfite and monosodium glutamate because it would inhibit post-slice browning and darken the potatoes (Borders et al., Col. 8, lines 50-54) for the intended application, since it has been held that discovering

an optimum value or a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

The modified teaching of Spaeti et al., in Burrows et al., discloses drying the potatoes in a cabinet dryer but does not disclose the lengthened time period of the presently claimed; however, it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the time of drying to 6-8 hours because it would allow for the appropriate moisture content of the final product for the intended application, since it has been held that discovering an optimum value or a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spaeti et al., in view of the combination of Harris, Dill, Mid Hill Nursery, Murakami, Siamon, and Willard, as applied to claims 1-3, 7-9, and 11-15 above, further in view of the combination of Prater et al.

The references of: Antioxidant Properties of Dry Soup, and Borders et al., are relied on for evidence.

All reference as applied to claims 1-3, and 7-15 above, are incorporated herein.

Regarding claim 6, the modified teaching of Spaeti et al. does not disclose drying and grinding of onion by slicing the onion, drying the onion, and grinding to form onion powder.

Prater et al. discloses forming dehydrated onion powder by first slicing the onion (Col. 3, lines 22-26; Col. 4, lines 1-4), drying the onion from a temperature between 130-230ºF (54.4-110ºC), and milling the onion so 25% passes through a 60 mesh sieve (251µm) and a 100 mesh sieve (152µm) (Col. 4, lines 9-22).

It would have been obvious to one of ordinary skill in the onion art at the time of the invention to modify the process drying onion to include the drying and milling of Prater et al. because it allows for the final product to be more uniform and possess strong flavor effects (Col. 1, lines 31-35), and because one of skill in the art would have a reasonable expectation of success from a teaching that illustrates that the art recognizes such steps to be effective for the intended use of dehydrating onions.

Response to Arguments

Applicant presents the arguments that their instant invention is allowable because:

1) It is from a discovery of a new and useful soup mix based on Indian dill.

In response, since the claimed preparation of soup mix concoction is merely the addition of common ingredients, and such ingredients that are prepared by using a combination of previously known food science methods step, attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in fact situation of the instant case. At page 234, the Court stated as follows:

> This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of

> preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected and useful function. In re Benjamin D. White, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

2) The making of the soup involves a highly specific combination of ingredients in a highly specific ratio of amounts.

In response, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the method of making a soup mix, as known, to include any specific ratio of ingredients, including the ratio of ingredients claimed, because one of skill in the art would have a reasonable expectation of success when relying upon their skills to develop a recipe that is palatable to the consumer. Further, attention is draw to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in fact situation of the instant case. At page 234, the Court stated as follows:

> This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected and useful function. In re Benjamin D. White, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

3) The particularly claimed process for making the claimed soup mixture is highly specific and involves highly specific preparatory steps.

4) None of the steps claimed (i.e. the totality of limitations) are not taught or fairly suggested by the cited prior art either alone, or in combination.

In response to item 3 and 4, each limitation has been carefully addressed in the office action provided, previously and presently, and although some skill is relied on of those of skill in the art to optimize a process parameter, adjust a result effective variable, or make a minor adjustment, the person having ordinary skill in food science, would, of necessity have the capability of understanding the required steps of preparing the claimed instant soup mix through the use of the teaching in the art and their own skill and creativity. The concept of dried soup mixes are long known, as well as methods for drying ingredients to make a dried food mixture. It is the opinion of the office that the instant invention is merely a recipe or formula for cooking food which involves the addition or elimination of common ingredients, and is for treating said ingredients in ways which are not outside of the skill of one in the art because the general concepts of the method steps used are known in the former practice of the art. *Therefore the limitations do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent.*

5) Applicant argues that because a variety of references are used to reject the instant invention, that the combination of the numerous references indicates the use of impermissible hindsight.

In response, the combination of two or more references is "hindsight" because the "express" motivation to combine the references is lacking. However, there is no requirement that an "express, written motivation to combine must appear in prior art references before a finding of obviousness, and therefore such a combination is permissible. See Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004) and MPEP Section 2145 X.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Applicant claims a process for making a dry soup mix, and the process steps comprise known steps of mixing of a preparation of pulverized ingredients and drying them. The claimed preparation of the soup mix concoction is merely the addition of common ingredients, and the preparation of such ingredients by using a combination of previously known food science methods. Only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was taken into account when examination occurred and it did not require knowledge gleaned only from applicant's disclosure because the general concepts of the instant invention, drying food products and combining them to form a dry food mixture which is dried again to insure a water content which will provide a reasonable shelf life, are steps which are long known in the food art. Methods of drying

and using dried foods are of the oldest methods known to the preparation of food, and the rejection of each and every step of the instant invention is proper because it relies on a reconstruction of what was known in the art. See In re McLaughlin 443 F.2d

In the instant invention, obviousness was established by combining and modifying the teachings of the prior art to produce the claimed invention with teachings, suggestions, and motivation to do so. It was determined that a person of ordinary skill will be able to fit the teachings of the multiple applied references together like pieces of a puzzle though the inferences and creative steps that a person of ordinary skill in the art would routinely employ. The hypothetical person having ordinary skill in food science, would, of necessity have the capability of understanding the required steps of preparing the claimed instant soup mix.

Further attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in fact situation of the instant case. At page 234, the Court stated as follows:

> This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected and useful function. In re Benjamin D. White, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A. George whose telephone number is (571) 272-5955. The examiner can normally be reached on Tue. - Fri. between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1794

/Patricia A George/
Examiner, Art Unit 1794

Patricia A George
Examiner
Art Unit 1794